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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,744	11/13/2001	Richard M. Peterson	SMD-58	3562

7590 08/04/2003

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EXAMINER

WALLS, DIONNE A

ART UNIT PAPER NUMBER

1731

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/054,744	PETERSON ET AL.	
	Examiner	Art Unit	
	Dionne A. Walls	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 and 40-51 is/are allowed.
- 6) ☒ Claim(s) 21-23, 27-34 and 36-39 is/are rejected.
- 7) ☒ Claim(s) 24-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on May 19th, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 21-23, and 27-34, and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al (US. Pat. No. 5,878,753).

Peterson et al discloses a process for producing a paper wrapper having reduced ignition proclivity characteristics when incorporated into a smoking article comprising applying multiple layers, on top of each other, of any film-forming composition to form treated areas on the wrapper which are separated by untreated areas, said treated areas having a permeability to reduce ignition proclivity (see entire document). While Peterson et al may not specifically state that a first layer contains a composition in a first amount, and a second layer contains a composition in a second amount less than the first, the Examiner believes that Peterson et al *infers* this when it states that the layers, which comprise bands on the paper wrapper, could be formed by layers having a *successively decreasing width*, said bands being applied in a multiple pass gravure

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printing operation (col. 11, lines 12- 18). It follows that for the band to have a "successively decreasing width", there must be less and less film-forming material applied with each layer. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to apply a second amount, for the second layer, less than the first layer amount in order to ensure the decrease in "width" of the second layer so that a "step-up" profile could be formed. Further, it follows that the first and second amounts are applied in the claimed "weight per area basis", since a particular/certain amount of substance would be applied per area (i.e. section) of the paper web.

Regarding claim 23, while there may be no specific articulation with respect to the exact amount of film-forming material based upon the weight of the wrapper, for each of the layers, it would have been obvious to one having ordinary skill in the art at the time of the invention perform routine experimentation to arrive at the claimed amounts so as to ensure optimal amounts of substance in each layer in order to provide an effective smoking article with reduced ignition proclivity.

Regarding claims 31-34 and 38-39, while Peterson et al may not specifically recite the claimed substances to be used as the film-forming substance of its invention, it does state that any type of film-forming substance can be used as permeability reducers. (col. 9, lines 26-38). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilized any of the claimed substance since they are conventional in the cigarette art and known for their ability to reduce the porosity of cigarette paper.

Regarding claim 36, while there is no articulation with respect to the BMI of the treated discrete areas, it follows that since the paper wrapper of the Peterson et al reference has met all the other limitations of the process for producing a paper having reduced ignition proclivity, said wrapper would also exhibit the claimed burn rate characteristics.

Allowable Subject Matter

3. Claims 1-20 and 40-51 are allowed.
4. Claims 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed on May 19th, 2003 have been fully considered but they are not persuasive.
 - Applicant argues that the Peterson reference does not disclose the application of film-forming composition in a "weight per area basis". However, the Examiner disagrees and, as pointed out in the above rejection, believes that the Peterson reference necessarily discloses the application of the substance in a "weight per area basis", because a certain amount of the substance is applied per section of paper web. If Applicant intended for the "weight per area basis" limitation to mean something other than that which the Examiner has interpreted, it is not clear from the instant specification what that intention could be, as such

"weight per area basis" wording/concept does not appear to be disclosed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls", followed by a long horizontal line extending to the right.

Dionne A. Walls
August 2, 2003